

REMARKS

Claims 1-3 and 5-10 are pending.

Claims 1, 3, and 7 are independent claims.

All claims have been rejected.

Specification

The Specification has been editorially amended and a new Abstract has been presented to comply with U.S. practice.

The Examiner is requested to approve the changes to the Specification and new Abstract.

Drawings:

The indication that the drawings filed were accepted is noted.

Foreign Priority:

The Examiner is requested to acknowledge the claim for foreign priority that was previously filed.

Reply to Objection Under 37 C.F.R. § 1.75:

In Section 1 of the Office Action, the Examiner stated that if claims 2 and 4 were found allowable, claim 4 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. To expedite prosecution claim 4 has been cancelled.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the objection to claims 2 and 4.

Reply to Rejections:

First Rejection:

Claim 9 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is found in Section 3 of the Office Action. Claim 9 has been amended to depend from claim 8 and now does comply with 35 U.S.C. § 112, second paragraph.

Additionally, other editorial changes have been made to other claims as appropriate.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of claim 9 under 35 U.S.C. § 112, second paragraph.

Second Rejection:

Claims 1-7 were rejected under 35 U.S.C. § 102(b) as being anticipate [sic anticipated]¹ by Avants (USP 5,235,348). This rejection is traversed as to the remaining claims.

¹ Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed.Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F2d 628, 633, 2 USPQ2d 1051, 1054 (Fed.Cir. 1987). Nor does it require that the reference teach what

In rejecting base claims 1 and 7, the Office Action asserts, for example, that the structure recited "the connecting member being formed of a material which is more easily deformable than any one of the first support member, the second support member, and the writing head" (claim 1) and "connecting member being formed of a material which is more easily deformable than any of the first support member, the second support member and the writing head while also having a configuration which is more easily deformable than any one of the first support member, the second support member, and the writing head" (claim 7).

It is the Examiner's assertion that these features are shown in column 4, line 47 and column 5, line 13-14 of the reference. But there is no specific or inherent disclosure that supports the rejection. Also, while the Examiner asserts that plastic is found in column 5, lines 11-13, the fact that members 36 and 37 "are injection molded parts" does not mean they are plastic either specifically or inherently. In fact, a metal part can be formed by injection molding. See for example, column 1, lines 19-21, of the reference.

the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp. 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed.Cir. 1983), cert. denied. 465 U.S. 1026 (1984).

Base claim 3 has at least the structure of "the connecting member having a configuration which is more easily deformable than every one of the first support member, the second support member and the writing head."

This is not shown inherently or specifically in the reference.

As each and every limitation of the base claims 1, 3, and 7 are not shown either specifically or inherently, a rejection based on 35 U.S.C. § 102 is not viable.

Furthermore, even if the structure claim was a possibility or probability in the reference, which it is not, a rejection based on possibility or probability is not proper. See *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 Fed 2d. 1264, 1268-1269, wherein the Court stated as follows:

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled...[such] that the missing...matter is necessarily present in the...reference, and that it would be so recognized by persons of ordinary skill..."Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result form a given set of circumstances is not sufficient."

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102.

Third Rejection:

Claims 8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Avants in view of Cooper, et al. (USP 6,396,524). This rejection is traversed.

The addition of Cooper does not cure the inherent deficiencies of a rejection based on Avants.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

Additional Art Cited:

Additional art was cited but as it was not applied, no further comments are considered necessary.

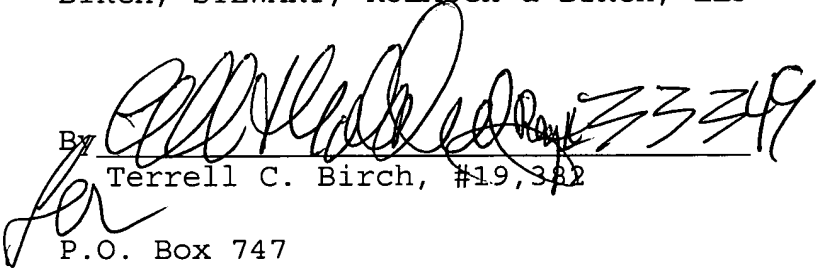
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  33349
Terrell C. Birch, #19,382

TCB/EAG/lab/jeb
4492-0108P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment(s): Replacement Abstract